

S/N 09/672,523

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Kuriacose Joseph et al.	Examiner:	Yogesh Garg
Serial No.:	09/672,523	Group Art Unit:	3625
Filed:	September 27, 2000	Docket:	2050.001US3
Title:	METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below:

§251 Rejection of the Claims

Claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 were rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Applicants respectfully submit the Examiner has incorrectly interpreted and applied the rule and tests pertaining to 35 U.S.C. § 251 (MPEP 1412.02), impermissible recapture in broadened reissue claims.

The May 1, 2006 Office Action (hereinafter, "OA") on pages 3-5 applies the three step analysis of *In Pannu* to determine recapture (See MPEP 1412.02). In regards to section B of the OA, "The Second Step-Does Any Broadening Aspect of the Reissued Claim Relate to Surrendered Subject Matter?" the Examiner has indicated in the affirmative. The Examiner stated:

The limitations of the patent claims, which are omitted or broadened in the reissue claim was originally relied upon by applicant in the original application to make the claims allowable over the art (*see the prosecution history of '034 patent, specially the Amendment and remarks received on 1/12/1998 wherein the applicant has explicitly argued and relied upon the limitations now omitted from the reissue claims to overcome the prior art*) and therefore the omitted limitation relates to subject matter previously surrendered by applicant.

However, it is clear that the broadening aspects of the reissue claims do not relate to *subject matter* previously *surrendered* during the prosecution of the original application. As partially discussed in the Response to the OA (Response of 4/8/2004, hereinafter “Response”) on page 17, the subject matter of the limitations of the patent claims is substantially different than that of the reissue claims (See Response, page 17). In reviewing the prosecution history of the ‘034 patent as suggested by the Examiner, it is also clear that the subject matter of any amendment(s) to overcome the prior art is also substantially different than any of the subject matter of the limitations of the reissue claims. In that light, the Applicants respectfully assert *it is not possible to surrender subject matter that was never prosecuted* in the ‘034 patent. Further, nowhere in the arguments portion of the file history is there any argument suggesting the subject matter of the present reissue claims was omitted to overcome the prior art. The Examiner has offered no concrete and explicit example of where in the prosecution history the Applicants have surrendered this subject matter, but merely offered a general statement citing the entire Amendments and Remarks section of the 1/12/1998 Response (OA pages 4 and 5).

As indicated by the last sentence of MPEP 1412.02.I.B.1, “If there was no surrender of subject matter made in the prosecution of the original application, again the analysis ends and there is no recapture.” In this case, the Applicants mistakenly failed to claim subject matter pertaining to a disclosed embodiment. MPEP 1412.01 states, “...the mere failure to claim a disclosed embodiment in the original patent (absent an explicit statement in the original patent specification of unsuitability of the embodiment) would **not** be grounds for prohibiting a claim to that embodiment in the reissue.”

For at least the reasons discussed above and the reasons set forth in the last Response (See Response, pages 15-21), there was no surrender of subject matter pertaining to the reissue claims in the prosecution history of the original application and it is respectfully requested this rejection be removed.

§103 Rejection of the Claims

Claims 10, 12, 15-16, 21-25, 28, 33-36, 38, 40, 43, 50-54, 58, 60, 63-66, 260, and 262-263 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. (U.S. 5,621,456) in view of Schlafly (U.S. 4,734,858).

Claims 11, 29, 39 and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly as applied to claims 10, 28, 38 and 58 above, and further in view of Zachary et al. ("Technology: HP is building Gadget to Make TVS Interactive").

Claims 13-14, 17, 31-32, 41-42, 45 and 61-62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly as applied to claims 10, 28, 38 and 58 above, and further in view of Pires (U.S. 4,163,255).

Claims 37, 54-55, 67 and 246-253 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly as applied to claims 25, 28, 53 and 58 above, and further in view of Harvey et al. (U.S. 4,965,825).

Claims 27 and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly as applied to claim 26 above, and further in view of Harvey et al.

Claim 261 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly as applied to claim 260 above, and further in view of Harvey et al.

Claims 18-20 and 46-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly as applied to claims 10 and 38 above, and further in view of Mustafa et al. (U.S. 4,789,895).

As discussed in the Response of 4/8/2004 at pages 23 and 24, the ordering of an item, as disclosed in Schlafly, requires more than a single action with respect to the client. Specifically, to perform a catalogue order utilizing the system and methodology disclosed in Schlafly, a user is required to provide an individual subscriber secret personal authorization number, which is followed by sequentially occurring prompts responsive to which the user enters a code specifying a supplier by a catalogue and page number, the nature of the transaction, and the quantity and options pertaining to the relevant order. In short, Schlafly simply does not disclose placing an order for an item by a single action with respect to a client, but instead clearly discloses a sequence of actions. Schlafly is accordingly cumulative

with the disclosures provided in Florin. Adding the teachings of Zachary, Pires, Harvey, and Mustafa alone or in combination with Florin fail to cure Florin's deficiencies.

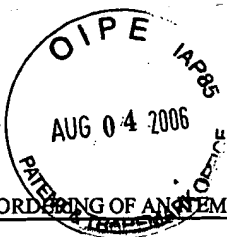
The remaining independent claims each include limitations which are substantially similar to those of claim 10. The dependent claims are deemed to include all limitations of claims from which they depend, and the above remarks similarly address the rejections presented under 35 U.S.C. §103 against these dependent claims.

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CONCLUSION

The Applicants respectfully submit that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 408-278-4045 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

KURIACOSE JOSEPH ET AL.

By their Representatives,

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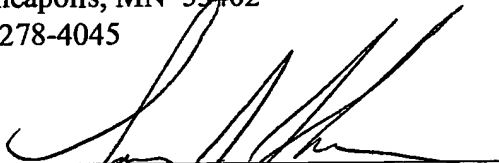
Minneapolis, MN 55402

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Date

8/1/2006

By


Larry J. Johnson
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 1st day of August 2006.

Name

Peter Rebutten

Signature

